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In re Application of
KO et al.
Serial No.: 10/572,563
PCT No.: PCT/CN04/01044
Int. Filing Date: 14 September 2004
Priority Date: 17 September 2003
Atty Docket No.: 8964-000031/US
For: A FUNGAL IMMUNOMODULATORY
PROTEIN PRODUCED BY MICROORGANISMS
AND USES THEREOF

DECISION ON PETITION
UNDER 37 CFR 1.47(a)

This decision is in response to applicant's "PETITION UNDER 37 CFR 1.47(a)" filed 02 April 2007 to accept the application without the signatures of joint inventors, HSU-WEI HUNG, HO-LUNG JIANG, CHING-LING HU AND CHENG-CHUN KUAN. Applicant also requests a five month extension of time, which is granted.

BACKGROUND

On 17 March 2006, applicant filed a request for entry into the U.S. national stage, along with the basic national fee.

On 01 September 2006, a Notification of Missing Requirements was mailed to applicant indicating that an oath or declaration, in compliance with 37 CFR 1.497(a) and (b), is required.

On 02 April 2007, applicant filed a petition under 37 CFR 1.47(a) to accept the application without the signatures of joint inventors HSU-WEI HUNG, HO-LUNG JIANG, CHING-LING HU AND CHENG-CHUN KUAN.

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(g), (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor.

Items (1), (3) and (4) above are satisfied.

Regarding item (2)¹ above, Petitioner contends that HSU-WEI HUNG, HO-LUNG

¹ Section 409.03(d) of the MPEP, Proof of Unavailability or Refusal, states, in part:

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be

JIANG, CHING-LING HU AND CHENG-CHUN KUAN have refused to sign the application.

Specifically, applicant submitted the declaration of Tzu-Chih Chen, who states that a copy of the application along with declaration and assignment were mailed to the nonsigning inventors at their last known address. Chen's declaration does not appear to be a statement of first hand knowledge and there is no indication of his knowledge or position established in the declaration. Moreover, although Enclosure 1 is referenced in the declaration, it is not found among the papers submitted.

The joint declaration of David Ko and Jash Lin was also submitted in support of the 37 CFR 1.47(a) petition. The declaration indicates that "a copy of both the Declaration and Assignment documents...and the patent disclosure were forwarded to each of the named inventors at their last known mailing address." According to their declaration, the letter advised the inventors that they could verify the scope and accuracy of the disclosure by referencing the international application using the World Intellectual Property Organization website. It is not clear that the nonsigning inventors received a complete copy of the application papers, as required. See MPEP 409.03(d) set forth in Footnote 1.

Declarant Lin states that when he contacted them, inventors Hung, Jiang and Kuan refused to sign the declaration. However, the details of their refusal are not set forth in the declaration and the accompanying documents are not translated into English. As for inventor Hu, Lin indicates that he was unable to contact Hu, without providing details of his attempts.

Moreover, the attachments referenced in their declaration (alleged mail receipt and phone record) are in the Chinese language. A translation into English of all evidence relied upon must be submitted, in order to be considered.

In sum, the declaration merely indicates "the patent document"; this does not make clear "which" document was enclosed and does not confirm that a complete copy of the application was provided to the inventors. The documentary evidence does not support the declarants'

specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Proof that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature, but the inventor refused to accept delivery of the papers or expressly stated that the application papers should not be sent, may be sufficient. When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the statement of facts. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the statement of facts. The document may be redacted to remove material not related to the inventor's reasons for refusal.

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the statement of facts in support of the petition or directly in the petition. If there is documentary evidence to support facts alleged in the petition or in any statement of facts, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the petition.

statement that they sent a complete copy of the application to the inventor. Petitioner must provide the nonsigning inventor a complete copy of the application papers before a petition under 37 CFR 1.47(a) can be granted.

It is unclear whether the nonsigning inventors received the papers and whether the papers did in fact contain a complete copy of the application including an oath or declaration for execution. The declarations provided cannot be relied upon to fulfill the requirements of 37 CFR 1.47(a) and granting of the petition. In cases where it is argued that the non-action of an inventor should be considered a refusal to cooperate it is especially important to provide proof of delivery of the papers, as well as, a firsthand statement of the preparation and mailing of the papers.

As stated above, where a refusal of the inventor to sign the application papers is alleged, a statement of facts is needed from a person having first hand knowledge of the facts that a complete copy of the papers *for this application* (specification, claims, drawings and oath/declaration) were sent to Hung, Jiang, Kuan and Hu, and *when such papers were sent*. In addition, copies of documentary evidence such as a certified mail return receipt, cover letter of instruction, telegrams, etc., should be supplied with the declaration. All documentary evidence should be translated into English. *See MPEP 409.03(d)* for further clarification.

Applicant has not presented sufficient evidence to show that (1) Messrs. Hung, Jiang, Hu and Kuan were presented with and received a complete copy of the application papers including a declaration and (2) they refuse to sign the application papers. In light of the above, Item (2) above is not yet satisfied and thus, it is inappropriate to grant applicant's petition under 37 CFR 1.47(a) at this time.

CONCLUSION

For the reasons stated above, applicant's petition under 37 CFR 1.47(a) is **DISMISSED**.

Any reconsideration on the merits of this petition must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be directed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

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